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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,494	07/26/2001	Samuel L. Forusz	70452P002	9795
8791	7590	11/26/2003	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			PRATT, HELEN F	
			ART UNIT	PAPER NUMBER

1761

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,494

Applicant(s)

FORUSZ ET AL.

Examiner

Helen F. Pratt

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 6 and 10 are indefinite in the use of the term "periodic amount" of dietary fiber. It is not known what is intended by this phrase. Applicants might mean, "predetermined amount" of dietary fiber as in paragraph 0003 of the specification.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,436,446. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the claims show the instant ingredients, and it would have been obvious to one of ordinary skill in the art to make a product with a particular viscosity with known ingredients. Further nothing is seen that the claimed viscosity is not disclosed by the above reference as the ingredients are the same.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-12 are rejected under 35 U.S.C. 103(e) as being unpatentable over by Forusz et al. (6,436,446).

Forusz et al. disclose a composition which can be a clear beverage, containing inulin and maltodextrin, which has an acidity of from 3-7 pH and is clear at within the claimed amounts (col. 2, lines 13-24 and col. 3, lines 6-15, col. 4, lines 15-40, col. 4, lines 5-14, 33-45). Vitamin C (ascorbic acid) is disclosed as claim 4 (col. 4, lines 5-14). Administering the beverage is disclosed in col. 10, lines 55-60). Certainly the collective amount of fiber is part of a predetermined amount of fiber. Claims 1 -4, 6 differ from the reference in the particular viscosity of the composition. However, as the claimed ingredients have been shown, it would have been within the skill of the ordinary worker to achieve a particular viscosity using known ingredients. Therefore, it would have been obvious to use known ingredients in the claimed composition to make a particular viscosity.

Claim 7 requires less than the daily, predetermined amount of soluble fiber and claim 8 that the beverage can be a dry mix to be combined with a liquid which can be water as in claim 9. It would have been within the skill of the ordinary worker to use

particular amounts of fiber depending on the required viscosity of the fiber and the required function of the product. Dry mixes to be mixed with water are disclosed in col. 3, lines 38-45. Therefore, it would have been obvious to make a beverage containing a soluble fiber in particular amounts and to combine a dry mix with water.

The particular limitations of claims 10 –12 have been disclosed above and are obvious for those reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stillman (6,248,390) or Topping (6,245,326) in view of Green (EP 0756 828).

The claims are rejected for the reasons of record cited in the last office action and for these further reasons as to the remaining references. Stillman discloses a beverage containing water and the soluble fibers, inulin and maltodextrin, which is optically clear and which contains predetermined amounts of from 0.1% to 10% fiber (col. 4, lines 54-60 and col. 15, lines 60-70). Optically clear is seen to read on translucent as translucent is being seen as the least clear that the product can be. Topping discloses a composition containing inulin and maltodextrin, which can be a beverage (col. 2, lines 53-59, col. 4, lines 7-9 and lines 64-68). Claim 1 differs from the

reference in the particular viscosity of the beverage at a particular pH of less than six. The particular viscosity is not given in Stillman or Topping, but the reference to Stillman states that the product is "fiber-water" and is readily substituted for bottled water (col. 6, lines 38-44). Nothing is seen that this viscosity would not be about what is claimed especially as the limitation is "on the order of 1.4 centipoise" which allows for various degrees of viscosity relatively close to 1.4 cp's. Also, Green discloses a soluble fiber, inulin and a second soluble fiber in amounts from 8-40% as in a dry mix (col. 3, lines 12-30). The composition can be mixed with water in amounts of 2 grams, which surely has a viscosity of less than 1.4 cp or less. Nothing is seen that this is not the case (col. 4, lines 36-41 of Green). No pH is given for the beverage in the reference to Stillman, but since the composition contains the same ingredients of fibers and a beverage, i. e. water as in the reference, the pH should be the same. Water generally has a pH of 5.9 to more than 6 depending on the hardness of the water. Since the composition is even clear, then the product must have the same pH, otherwise the fibers would come out of solution and create a more than translucent beverage. Therefore, it would have been obvious to make a product containing the claimed ingredients as shown by Stillman and Topping, at a particular pH and viscosity.

Claims 1, 6 and 10 have been amended to require that the second soluble fiber is "selected from the group consisting of at least one of". Applicants claims are open comprising claims even though the second soluble fiber is selected from the group consisting of at least one of maltodextrin, polydextrose and acacia gum. Since the claim is open, other fibers can be in the composition. Therefore, it is seen that other

ingredients can be added to the claims beside the above. As to fiber in a predetermined amount, generally, this is the case in making a composition. Therefore, it would have been obvious to use fiber in predetermined amounts and to choose particular ingredients to make the composition.

The limitations of claims 10 and 11 have been discussed above and are obvious for those reasons. The claim also requires particular amounts of ingredients, which are seen as being shown by the reference to Stillman since it is optically clear. Stillman discloses from 0.1 to 10% water-soluble indigestible fiber. Even though the amounts of fiber are not broken down, it is seen that it would have been within the skill of the ordinary worker to use particular amounts particularly as Stillman uses enough to still make a clear beverage. Therefore, it would have been obvious to use particular amounts of ingredients to make a translucent beverage.

Claim 12 further requires a particular ratio of ingredients. However, nothing critical is seen in the particular amounts absent a showing of unobvious results. The function of the various dietary fibers is well known. Therefore, it would have been obvious to use the fibers in particular amounts for their known functions.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the above combined references as applied to the above claims, and further in view of Christine (French application No. 2778849 on applicants' IDS).

The claim is rejected for the reasons of record cited in the last office action.

ARGUMENTS

Applicant's arguments filed 9-29-03 have been fully considered but they are not persuasive. Applicants argue that Stillman contains inulin and guar gum and that the overall viscosity of the translucent composition is not specified, that no pH is found and that the composition is in a water-soluble dry form. However, Stillman can contain the claimed maltodextrin plus inulin (col. 15, lines 37-45). The final viscosity is seen to have been shown in that the ingredients are used in amounts to make a clear beverage and the beverage is "a water composition". Nothing has been shown that a composition that is mostly water does not have a viscosity as claimed. Certainly a range of from 0.1% to 10% of soluble fibers as in Stillman reads on the claimed viscosity. As to the pH, water can have a pH of as low as 5.9, which is within the claimed range depending on the various salts in the composition (col. 15, lines 10-19). As to the composition of Stillman containing a water-soluble dry form, this is not seen as claim 1 states that the composition contains "safe water" (col. 15, lines 14-19).

Applicants argue that Green does not disclose their claimed fibers or viscosity or pH. However, it was used to show the use of inulin and a second soluble fiber in particular amounts in a dry mix which can be mixed with water which could have a viscosity of less than 1.4 cp or less. Nothing has been shown that this is not the case. The office does not have the facilities to make such a determination.

Applicants argue that Topping does not disclose the claimed limitations of viscosity or pH, but is toward a bulking composition. However, if a composition contains fiber, this is a function of fiber to form bulk. Nothing is seen that applicant's composition will not also do the same. As in the rejection, if the composition is shown,

then the product should be translucent. A pH of less than six has been shown by Green.

Applicants argue that the reference to Christine does not show the viscosity or pH and has a fiber content of 40%. However, it was used to show that it is known to use acid in a beverage. No level of soluble fiber is seen in the independent claims of a level of approaching 40%. Claims 3 uses .0026% as the lowest amount and claim 10 requires only "up to 33% by weight". Nothing has been shown by the way of a showing that the clear beverage of even Stillman could not have the claimed amounts of ingredients. Applicants have not answered why beverages, which are clear, would not have the same amounts of ingredients as claimed, particularly in open comprising type claims.

Applicants argue along the same lines as above as to claims 6-12, which arguments have been discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Hp 11-14-03

H. Pratt
HELEN PRATT
PRIMARY EXAMINER